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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,134	12/29/2000	Gary L. Shanklin	659/766	1798

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EXAMINER

SALVATORE, LYNDIA

ART UNIT                      PAPER NUMBER

1771

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/753,134	<b>Applicant(s)</b> SHANKLIN, GARY L.	
	<b>Examiner</b> Lynda M. Salvatore	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,10-20,22 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,10-20,22 and 35-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response***

1. Applicant's remarks filed 05/26/05 have been fully considered and entered. Applicant's remarks regarding the prior art rejections made over Burghardt et al., and Krzysik et al., as set forth in sections 2-4 and 6 of the last Office Action are found persuasive. Specifically, the prior art of Burghardt et al., and Krzysik et al., does not qualify as prior art under 35 USC 102(e) since the instant invention was completed prior to July 29 1999 (pursuant to inventor declaration filed 11/24/03). In addition, Applicant properly invokes 103 (c) with respect to Burghardt et al. The subject matter of the present application and Burghardt et al., were, at the time the invention of the present application was made, commonly owned by Kimberly-Clark Worldwide, Inc. or subject to an obligation of assignment to Kimberly-Clark Worldwide. As such, these rejections are hereby withdrawn. However, despite this advance, there remain obviousness double patenting rejections as set forth below. In addition, Applicant's arguments are not found persuasive of patentability with respect to the prior art rejections based on Roth et al., in view of Walter et al., as set forth in section 5 of the last Office Action for reasons set forth herein below.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 5,6, 10-20,22 and 35-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-101 of copending Application No. 10/289557 (US 2004/0086726 A1) in view of Rothe et al., US 4,738,847.

The application issued to Moline et al., teach a multi-ply facial tissue comprising the claimed amine-modified polysiloxane composition. The general formula of the amine-modified polysiloxane is that of the Applicant's structure shown in claim 1 (Section 0027). Moline et al., does not teach providing an effective amount of antimicrobial agent, however, Rothe et al., discloses a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al., teaches applying the virucidal composition to the inner ply layer to reduce any irritation that may result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20).

Therefore, motivated to impart softness to a virucidal multi-ply absorbent article it would have been obvious to having ordinary skill in the art at the time the invention was made to apply the amine-modified polysiloxane composition of Moline et al., to the multi-ply virucidal absorbent article of Rothe et al.

4. Claim 4 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No.

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10/289557 (US 2004/0086726 A1) in view of Rothe et al., US 4,738,847 as applied to claim 2 above and further in view of Roe et al., US 5,635,191

The combination of prior art of Rothe et al., and Moline et al., fail to teach a liquid-impermeable base ply, however, the patent issued to Roe et al., discloses a disposable diaper comprising a liquid pervious top sheet having a fluid polysiloxane emollient/ lotion applied to the surface thereof (Abstract). The diaper construction generally includes the polysiloxane containing top sheet, an absorbent core, and a liquid impervious back sheet (Column 4, lines 18-24). Roe et al., discloses that the absorbent capacity of the core may be tailored suit a variety personal care needs such as diapers, sanitary napkins and incontinence pads (Column 5, lines 1-5).

Therefore, motivated by the desire to produce a virucidal disposable absorbent article it would have been obvious to one having ordinary skill in the art to provide the multi-ply article of Moline et al., in view Rothe et al., with a liquid-impermeable base ply as taught by Roe et al.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 35-41 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., US 4,738,847 in view of Walter et al., US 4,950,545 or US 5,227,242.

Applicant argues a lack of motivation to combine references. This argument is not found persuasive. The Examiner maintains that sufficient motivation exists to provide the multi-ply absorbent article comprising a virucidal composition of Roth et al., with a siloxane composition

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as taught by Walter et al. Specific motivation is found in the desire to impart softness to the absorbent multi-ply tissue article.

Recall, the patent issued to Rothe et al., discloses a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al., teaches applying the virucidal composition to the inner ply layer to reduce any irritation that may result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20). The plies may be made from webs of cellulosic creped wadding, however, non-woven webs synthetic polymeric fibers are also suitable (Column 2, lines 47-54). The three-ply absorbent article is suitable for use as facial tissues, bathroom tissues, paper towels or wipes (Column 1, lines 36-39). Suitable virucidal compositions include acids having the formula  $R-COOH$ , wherein R is selected from the group of lower alkyl; substituted lower alkyl; carboxy lower alkyl or carboxy dihydroxy (Column 1, lines 40-60).

Rothe et al., fails to teach adding a at least one siloxane composition to at least one outer ply, however, the patent issued to Walter et al., teaches applying a silicone compound to facial tissues to improve softness (Abstract '545 and '242). Suitable silicone compositions include various ganommodified polysiloxanes and mixtures of cyclic and non-cyclic-modified dimethyl siloxane (Column 2, 5-23-'545 and '242). Walter et al., specifically teaches printing the silicone compound onto the outer surfaces of the tissue (Column 6, 30-40-'545 and '242).

Therefore, motivated by the desire to provide a anti-microbial tissue product with improved softness it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to the print the outer surface of the multi-ply tissue product taught by Roth et al., with the silicone/siloxane compounds taught by Walter et al.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 17, 2005

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